

REMARKS

Claims 10 to 18 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 10, 13, 14, 17 and 18 were rejected under 35 U.S.C. § 101. While the rejections may not be agreed with, to facilitate matters, claims 10, 14 and 17 have been rewritten to reflect the broader aspects of claims 11, 12 and 15, 16, which were not rejected under Section 101. The law on Section 101 is incorporated by reference to the extent that the Section 101 rejections are maintained. It is therefore respectfully requested that the Section 101 rejections be withdrawn (to the extent that they are maintained) as to the foregoing claims.

Claims 10 to 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kleider et al., U.S. Patent No. 6,084,919 in view of Bruckert et al., U.S. Patent No. 5,822,359 and the “Klein et al.” article “Zero Forcing . . . “

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with (including for the reasons previously explained), to facilitate matters, claims 10, 14 and 17 now provide that *the intersymbol interference and the multiple access interference are exclusively accounted for in the base station*. This feature is disclosed and explained at page 5 of the specification of the present application. Any review of the applied references makes plain that this feature is nowhere disclosed or suggested by any of the applied references, whether taken alone or combined.

Accordingly, claims 10, 13 and 17, as presented, are allowable for these reasons alone, as are their respective dependent claims.

Also, as previously explained, searching for separate hints towards different aspects, such as, for example, "zero forcing and minimum mean-square-error equalization for multi-user detection in CDMA channels" as in Klein, does not mean the skilled person would combine Kleider and Klein to provide the subject matter of claim 10, because it would not be known how to provide the benefits of the claimed subject matter, e.g., to cancel ISI and/or MAI at the sender and hence allow a significant simplification of the hardware at the receiving side.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the

reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

Accordingly, claims 10, 13 and 17, as presented, are allowable for these reasons alone, as are their respective dependent claims.

Conclusion

It is therefore respectfully submitted that all of claims 10 to 18 are allowable. It is therefore respectfully requested that the rejections and any objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

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